

Serial No. 10/672,695  
Filed: 4/11/2002  
Inventor: Boyle, et al.  
Attorney Docket: 6006-107  
Customer No. 29,335

### REMARKS

In response to the Office Action mailed November 22, 2005, Applicants submit this Second Supplemental Response to Restriction Requirement. Furthermore, Applicants incorporate as if fully restated herein, Applicants' Prior Response to Restriction Requirement filed on June 15, 2005 and Applicant's Prior Supplemental Response to Restriction Requirement filed September 19, 2005. To expedite the prosecution process, Applicants cancel claims 7, 16, 17, 25 and 28, amend claim 18, and withdraw claims 13, 14, 32 and 33.

In response to the Examiner's election of species requirement, Applicants provisionally elect with traverse to prosecute species 2, the thin film/graft shown in Fig. 6; subspecies 17, the structural support element shown in Figure 3; and subspecies 35, "wherein the microporous metal thin film covering maintains a martensite crystalline structure throughout a temperature transition from room temperature to body temperature and behaves martensitically in vivo." Applicants submit that pending claims 1-6, 8-12, 15, 18-24, 26-27, 29-31, and 34-35 are directed to the elected species and subspecies. Additionally, Applicants submit that pending claims 1-6, 8-10, 12, 15, 18-24, 26-27, 29-31, and 34-35 are generic.

Each figure in the pending application involves aspects of the implantable endoluminal graft. The claimed invention includes three key aspects: a thin film, a structural support, and contact point(s) joining the thin film to the structural support. Certain figures may focus on specific aspects -- thin film, structural support, and/or contact point(s) -- of the invention, and each specific aspect may have different embodiments illustrated in the various figures. Nonetheless, as currently claimed, pending claims 1-6, 8-10, 12, 15, 18-24, 26-27, 29-31, and 34-35 are written broadly, such that each of these claims is generic and reads on every specie embodied in every figure in the application.

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For clarification purposes, Applicants submit below Table 1, which lists each figure's subject matter(s). Additionally, Table 2 below outlines correlation between pending claims and figures.

**Table 1: Figures and Corresponding Claimed Structures of Invention**

Figure	Structural Support	Thin Film (Graft)	Contact Point(s) (Attaching Thin Film to Structural Support)
1	√		√
2	√		√
3	√		√
3A	√		
4	√	√	
5	√		√
6		√	
7		√	
8		√	
9		√	
10		√	
11		√	
12		√	
13		√	
14		√	
15		√	
16		√	
17		√	
18		√	
19		√	
20		√	
21		√	
22		√	
23		√	
24		√	
25		√	
26		√	
27	√		√
28A	√		
28B	√		

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Figure	Structural Support	Thin Film (Graft)	Contact Point(s) (Attaching Thin Film to Structural Support)
29	√		
30	√		
31	√		
32	√		
33	√		
34	√		
35	√		
36	√		
37	√		
38	√		
39	√		
40	√		
41		√	

**Table 2: Claims and Corresponding Figures**

Claim No.	Covers Elected Specie?	Reads on Embod. in Fig. No.	Thin Film Maintains Martensite Crystalline Structure	Thin Film Maintains Austenite Crystalline Structure	Thin Film Undergos Phase Transition From Martensite to Austenite Crystalline Structure
1 (Original)	Yes	1-41			
2 (Original)	Yes	1-41			
3 (Original)	Yes	1-41			
4 (Original)	Yes	1-41			
5 (Original)	Yes	1-41			
6 (Original)	Yes	1-41			
8 (Original)	Yes	1-41			
9 (Original)	Yes	1-41			

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Claim No.	Covers Elected Specie?	Reads on Embod. in Fig. No.	Thin Film Maintains Martensite Crystalline Structure	Thin Film Maintains Austenite Crystalline Structure	Thin Film Undergos Phase Transition From Martensite to Austenite Crystalline Structure
10 (Original)	Yes	1-41			
11 (Original)	Yes	1-41	√		
12 (Original)	Yes	1-41			
13 (Withdrawn)		1-41		√	
14 (Withdrawn)		1-41			√
15 (Original)	Yes	1-41			
18 (Currently Amended)	Yes	1-41			
19 (Original)	Yes	1-41			
20 (Original)	Yes	1-41			
21 (Original)	Yes	1-41			
22 (Original)	Yes	1-41			
23 (Original)	Yes	1-41			
24 (Original)	Yes	1-41			
26 (Original)	Yes	1-41			
27 (Original)	Yes	1-41			
29 (Previously Presented)	Yes	1-41			
30 (Original)	Yes	1-41			
31 (Original)	Yes	1-41			
32 (Withdrawn)		1-41		√	
33 (Withdrawn)		1-41			√

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Claim No.	Covers Elected Specie?	Reads on Embod. in Fig. No.	Thin Film Maintains Martensite Crystalline Structure	Thin Film Maintains Austenite Crystalline Structure	Thin Film Undergos Phase Transition From Martensite to Austenite Crystalline Structure
34 (Original)	Yes	1-41			
35 (Original)	Yes	1-41			

Applicants traverse the election of species requirement on the ground that there is no undue burden on the Examiner to search and examine all species. First, Applicants note that the Office Action mailed November 22, 2005 includes an error pertaining to species 35 and 36. Specifically, the two species as suggested by the Examiner are, in fact, the same. Both species were identified by the Examiner as “wherein the microporous metal thin film covering maintains a martensite crystalline structure throughout a temperature transition from room temperature to body temperature and behaves martensitically in vivo.” Clearly, two distinct species can not coexist if they are verbatim identical. Thus, this election of species requirement -- between subspecies 35, 36, and 37 -- as currently laid out by the Examiner is improper and indisputably wrong on face. The most reasonable interpretation that Applicants can conceive is that the Examiner intended for subspecies 36 to read “wherein the microporous metal thin film covering maintains a *austenite* crystalline structure throughout a temperature transition from room temperature to body temperature and behaves *austenitically* in vivo.” (Emphasis added for clarification.) Applicants kindly request that the Examiner clear up this matter of confusion.

Second, Applicants respectfully submit that there is no undue burden on the Examiner to search and examine all species. Pursuant to MPEP §803, the term “[r]estriction’ under 37 CFR 1.129(b) applies to both restriction requirements under 37

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CFR 1.142 and election of species requirements under 37 CFR 1.146.” Accordingly, the term “restriction,” a generic term, encompasses not only an election between distinct or independent inventions, but also an election of species. *See* MPEP §802.02. Thus, the criteria<sup>1</sup> for a proper restriction requirement also apply to an election of species requirement. Applicants respectfully submit that the Examiner has not established the “serious burden” requirement necessary to compel a restriction / election of species. *See* MPEP § 803 (“If the search and examination of an entire can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”) In spite of three restriction-related Office communications -- that of April 13, 2005, August 18, 2005, and November 22, 2005 -- the Examiner has still yet to establish why it would be a serious burden to search every embodiment present in the pending application, especially given that in the pending application, the differences between the disclosed species are merely substitution of conventional features.

Applicants further submit that the consequences of an improper election of species requirement are frustrating and very time consuming to deal with, and extremely costly. Accordingly, Applicants respectfully solicit the Examiner’s favorable reconsideration and quick withdrawal of the restriction requirement under 35 U.S.C. §111.

This Paper is being concurrently filed with an Amendment Transmittal, which includes a fee calculation sheet and any applicable requests for Extension of Time. Other than those stated in the Amendment Transmittal, no additional fees are believed necessitated by the filing of this Paper. Should any such additional fees be required, the Director is hereby authorized to deduct them from Deposit Account No. 18-2000, of which the undersigned is an authorized signatory.

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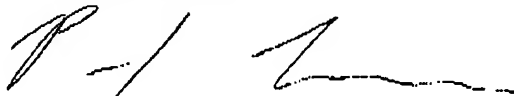
<sup>1</sup> The two criteria for a proper restriction/election of species requirement are (i) The inventions must be independent or distinct as claimed; and (ii) There must be a serious burden on the examiner if restriction is required. *See* MPEP § 803.

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Should the Examiner believe that there are any outstanding matters capable of resolution by a telephone interview, the Examiner is encouraged to telephone the undersigned attorney of record.

Applicant requests examination of pending claims 1-6, 8-12, 15, 18-24, 26-27, 29-31, and 34-35, as amended, and requests that such claims be allowed and pass to issue. Additionally, Applicants request that the Examiner reconsider and retract the Election of Species requirement that was compelled on withdrawn claims 13, 14, 32 and 34.

Respectfully submitted



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Docket No. 6006-107

Customer No. 29,335